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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/724,025 | 11/26/2003 | Christopher A. Pawlik | 02-40199-US | 7268 |
| 7066 | 7590 | 06/14/2005 | EXAMINER | |
| REED SMITH LLP 2500 ONE LIBERTY PLACE 1650 MARKET STREET PHILADELPHIA, PA 19103 | | | GRAY, LINDA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1734 | |

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,025

Applicant(s)

PAWLIK ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-26-03, 7-27-04, 8-27-04, 3-18-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date filed 2-3-05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Election/Restriction

1. Claims 16-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 3-18-05.

Specification

2. The specification is objected to because of the following informalities: **(a)** "10" should be -- 100 -- (p 5, L 13 and 28), **(b)** "20" should be -- 10 -- (p 4, L 16), and **(c)** page 1, the status of applications 09/898871, 08/662842, and 08/489611 should be added.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 165 (p 7, L 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, "said second surface" (L 1-2) lacks antecedent basis.

Claim 10, "said second surface (L 2) lacks antecedent basis.

Claim Rejections - 35 USC 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language, or

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartner (US 5,284,363).

Claim 1, Gartner et al. teach apparatus 8, for example, the apparatus shown in Figures 5A and 5B. The apparatus includes a first substantially planar member 20 and a second substantially planar member including layers 10 and 40. Member 20 and the second member are releasably adhered to each other in a peelable and resealable fashion (c 5, L 48, to c 6, L 16; c 3, L 51, to c 4, L 31).

The other limitations are recited in **claim 1** as an intended use of the claimed apparatus and do not provide a patentable distinction between claim 1 and the applied reference. The same applies to the limitations of **claims 2-5 and 8**.

Claim 6, member 20 and the second member each include first and second surfaces: member 20 - first surface 22 and second surface 33; second member - first surface 28 and second surface 45. Surfaces 22, 33, 28, and 45 include visible indicia 18. **Claim 7**, a portion of surface 22 includes adhesive 25 thereon.

8. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Sellars (US 2003/0027700 A1).

Claim 1, Sellars teaches an apparatus, for example, the apparatus shown in Figures 1A-1C. The apparatus includes a first substantially planar member 10 and second substantially planar member 60. Member 10 and member 60 are releasably adhered to each other in a peelable and resealable fashion (paras 24-31).

The other limitations are recited in **claim 1** as an intended use of the claimed apparatus and do not provide a patentable distinction between claim 1 and the applied reference. The same applies to the limitations of **claims 2-5 and 8**.

Claim 6, member 10 and member 60 each include first and second surfaces which are the tops and bottoms thereof (member 60: top surface 70 and bottom surface 80). The top of member 10 includes visible indicia, and surfaces 70 and 80 include visible indicia. **Claim 7**, member 10 is adhered to a back panel such that the bottom surface of member 10 includes adhesive thereon (para 31). **Claim 9**, member 60 is smaller than member 10 (para 2). **Claim 10**, there is provided an adhesive surface 80 which is deadened in portion 100 (**claim 11**) to a 50% deadening (**claim 12**). **Claims 13-14**, member 60 includes an outer edge where portions 100 and 110 are adjacent the edge.

9. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Bernier et al. (US 6,637,775 B1).

Claim 1, Bernier et al. teach apparatus 10. Apparatus 10 includes a first substantially planar member 14 and second substantially planar member 12 including.

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Member 14 and member 12 are releasably adhered to each other in a peelable and resealable fashion (c 2, L 53, to c 3, L 49).

The other limitations are recited in **claim 1** as an intended use of the claimed apparatus and do not provide a patentable distinction between claim 1 and the applied reference. The same applies to the limitations of **claims 2-5 and 8**.

Claim 6, members 14 and 12 each include first and second surfaces: first top surface 20 and second bottom surface 22 of member 14; first top surface 16 and second bottom surface 18 of member 12. Surfaces 16, 18, and 20 have visible indicia 24, 26, and 30 thereon, respectively. **Claim 7**, surface 22 includes an adhesive.

Claim Rejections - 35 USC 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al.

Claim 9, *Gartner et al.* do not teach the second member to be smaller than member 20.

However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and for this reason it would have been obvious to have optimized the relative size of the second member compared to the first member for optimal appearance.

Claim 10, surface 45 includes an adhesive thereon which is deadened in inner portions 38a (**claim 11**). **Claim 13**, the second member includes an outer edge where the deadening is adjacent the edge.

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Claims 12 and 15, *Gartner et al.* do not teach deadening 30%-50% and 5% of the edge.

However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and for this reason it would have been obvious to have optimized the percent of deadening for optimal release and reseal.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sellars.

Claim 15, *Sellars* does not teach less than 50% deadening, i.e., about 5% deadening.

However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and for this reason it would have been obvious to have optimized the percent of deadening for optimal release and reseal.

13. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernier et al.

Claim 9, *Bernier et al.* do not teach member 12 to be smaller than member 14.

However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and for this reason it would have been obvious to have optimized the relative size of the second member compared to the first member for optimal appearance.

Claim 10, surface 18 includes an adhesive thereon which is deadened in inner portions (**claim 11**). **Claim 13**, member 12 includes an outer edge where the deadening is adjacent the edge next to adhesive areas 50.

Claims 12 and 15, *Bernier et al.* do not teach deadening 30%-50% and 5% of the edge.

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However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and for this reason it would have been obvious to have optimized the percent of deadening for optimal release and reseal.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg

June 10, 2005


LINDA GRAY
PRIMARY EXAMINER